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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/725,198	12/01/2003	Paul Y. Moreton	02-40068-US-CON (932702.2)	9830
7590 REED SMITH LLP 2500 One Liberty Place 1650 Market Street Philadelphia, PA 19103-7301			EXAMINER TOMASZEWSKI, MICHAEL	
			ART UNIT 3626	PAPER NUMBER
			MAIL DATE 12/13/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/725,198	<b>Applicant(s)</b> MORETON ET AL.	
	<b>Examiner</b> Mike Tomaszewski	<b>Art Unit</b> 3626	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 October 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 22,29-35,38,40 and 41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 22,29-35,38,40 and 41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some    \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>10/3/07</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Notice To Applicant***

1. This communication is in response to the amendment filed on 10/3/07. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office Action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/3/07 has been entered.

Claims 1-21, 23-28, 36-37 and 39 have been cancelled. Claims 22, 29-34, 38 and 41 have been amended. Claims 22, 29-35, 38, 40 and 41 are pending. The IDS statements filed 10/3/07 has been entered and considered.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 22 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Ballantyne et al.* (5,867,821; hereinafter *Ballantyne*), in view of *Evans* (5,924,074;

hereinafter *Evans*), in view of *Lavin et al.* (5,772,585; *Lavin*) and in view of *Schultz et al.* (5,679,943; hereinafter *Schultz*).

(A) As per currently amended claim 22, *Ballantyne* discloses a personal assistant system, comprising:

- (1) a personal assistant (*Ballantyne*: abstract; col. 1, line 1-col. 2, line 63; Fig. 1-12B);
- (2) an electronic physician data module for collecting, storing, processing, and referencing information, the electronic physician data module being in said personal assistant (*Ballantyne*: abstract; col. 1, line 1-col. 2, line 63; Fig. 1-12B);
- (3) a sound recording device integral with said personal assistant (*Ballantyne*: abstract; col. 1, line 1-col. 2, line 63; Fig. 1-12B); and
- (4) a dictation module for electronically storing recorded voice from said sound recording device as a voice file, the automated dictation module being adapted to associate said voice file with said information (*Ballantyne*: abstract; col. 1, line 1-col. 2, line 63; Fig. 1-12B).

*Ballantyne*, however, fails to expressly disclose a personal assistant system, comprising:

- (5) an automated data collection module for inputting a patient identifier and relating said identifier with said information, the automated data collection module being in said personal assistant;
- (6) a voice to text module for translating said voice file into a text file; and
- (7) an information transmission device integral with said personal assistant;  
wherein the information transmission device is an alpha-numeric scanner.

Nevertheless, this feature is old and well known in the art, as evidenced by *Evans* and *Schultz*. In particular, *Evans* and *Schultz* disclose a personal assistant system, comprising:

- (5) an automated data collection module for inputting a patient identifier and relating said identifier with said information, the automated data collection module being in said personal assistant (*Evans*: abstract; col. 1, line 1-col. 3, line 43; Fig. 1-24);
- (6) a voice to text module for translating said voice file into a text file (*Lavin*: col. 1, line 65-col. 2, line 23); and
- (7) an information transmission device integral with said personal assistant;  
wherein the information transmission device is an alpha-numeric scanner  
(*Schultz*: abstract; col. 6, lines 50-61).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of *Evans* with the teachings of *Ballantyne* with the motivation of storing medical records in personal digital assistants (*Evans*: col. 1, lines 5-10).

One of ordinary skill would have found it obvious at the time of the invention to combined the teachings of *Lavin* with the combined teachings of *Ballantyne* and *Evans* with the motivation of providing a convenient means of storing and converting data (*Lavin*: col. 1, line 65-col. 2, line 1).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of *Schultz* with the combined teachings of *Ballantyne*, *Evans*, and *Lavin* with the motivation of providing an improved hand-held terminal (*Schultz*: col. 2, lines 60-63).

(B) As per currently amended claim 29, *Ballantyne* discloses the system of claim 22, further comprising a connection to an external computer (*Ballantyne*: abstract; col. 1, line 1-col. 2, line 63; Fig. 1-12B).

4. Claims 30-34, 38 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Ballantyne et al.* (5,867,821; hereinafter *Ballantyne*), in view of *Evans* (5,924,074; hereinafter *Evans*), in view of *Lavin et al.* (5,772,585; *Lavin*) and in view of *Schultz et al.* (5,679,943; hereinafter *Schultz*).

(A) As per currently amended claim 30, *Ballantyne* discloses a method of automatically associating information with an individual identified by an identifier, said method comprising:

- (1) storing said information in a personal assistant (*Ballantyne*: abstract; col. 1, line 1-col. 2, line 63; Fig. 1-12B); and
- (2) recording a voice file associated with said information (*Ballantyne*: abstract; col. 1, line 1-col. 2, line 63; Fig. 1-12B).

*Ballantyne*, however, fails to expressly disclose a method of automatically associating information with an individual identified by an identifier, said method comprising:

- (3) wherein said personal assistant comprises an alpha-numeric scanner;
- (4) scanning an identifier using an alpha-numeric scanner and relating said identifier with said voice file;
- (5) automatically associating the identifier with the information.

Nevertheless, this feature is old and well known in the art, as evidenced by *Evans* and *Schultz*. In particular, *Evans* and *Schultz* disclose a method of automatically associating information with an individual identified by an identifier, said method comprising:

- (3) wherein said personal assistant comprises an alpha-numeric scanner (*Schultz*: abstract; col. 6, lines 50-61);
- (4) scanning an identifier using an alpha-numeric scanner (*Schultz*: abstract; col. 6, lines 50-61) and relating said identifier with said voice file (*Evans*: abstract; col. 1, line 1-col. 3, line 43; Fig. 1-24); and
- (5) automatically associating the identifier with the information (*Evans*: abstract; col. 1, line 1-col. 3, line 43; Fig. 1-24).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of *Evans* with the teachings of *Ballantyne* with the motivation of storing medical records in personal digital assistants (*Evans*: col. 1, lines 5-10).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of *Schultz* with the combined teachings of *Ballantyne*, *Evans*, and *Lavin* with the motivation of providing an improved hand-held terminal (*Schultz*: col. 2, lines 60-63).

(B) As per currently amended claim 31, *Ballantyne* discloses the method of claim 30, wherein an identifier is a first alpha-numeric code uniquely associated with the individual (*Ballantyne*: abstract; col. 1, line 1-col. 2, line 63; Fig. 1-12B).

*Ballantyne*, however, fails to expressly disclose the method of claim 30, wherein the step of scanning an identifier is the act of scanning a first alpha-numeric code.



Nevertheless, these features are old and well known in the art, as evidenced by *Schultz*. In particular, *Schultz* discloses the method of claim 30, wherein the step of scanning an identifier is the act of scanning a first alpha-numeric code (*Schultz*: abstract; col. 2, lines 40-60; col. 6, line 15, col. 8, line 2; Fig. 1-74).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of *Schultz* with the combined teachings of *Ballantyne*, *Evans* and *Lavin* with the motivation of providing an improved hand-held terminal (*Schultz*: col. 2, lines 60-63).

(C) Claims 32-34 substantially repeat the same limitations of claim 31 and therefore, are rejected for the same reasons given for that claim and incorporated herein.

Moreover, Examiner notes that Applicant's duplication of bar codes (e.g., a second bar code associated with the information; scanning the second bar code, associating the information associated with the second bar code, etc.) has no patentable significance unless a new and unexpected result is produced. *In re Harza*, 274 F. 2d 669, 124 USPQ 378 (CCPA 1960).

(D) Claims 38 and 41 substantially repeat the same limitations as those of claim 22 and therefore, are rejected for the same reasons given for that claim and incorporated herein.

***Response to Arguments***

5. Applicant's arguments filed 10/3/07 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 10/3/07.

(A) On pages 5-10 of the 10/3/07 response, Applicant argues that *Ballantyne, Evans, Lavin* and *Schultz* do not teach an alpha-numeric scanner integral with a personal assistant.

In response, Examiner respectfully disagrees and submits that *Schultz* does indeed teach, suggest and disclose an alpha-numeric scanner integral with a personal assistant.

First, *Schultz* discloses a hand-held computer (i.e., personal assistant) having a bar code reader/scanner (*Schultz*: abstract; fig. 1-12). As readily apparent to one of ordinary skill in the art, a bar code (i.e., a series of bars and spaces encoded to correspond to alpha-numeric characters, such as a UPC symbol, etc.) is an alpha-numeric code, ergo, the *Schultz* personal assistant is a alpha-numeric scanner.

Second, *Schultz* discloses that the scanner is a CCD or laser scanner (*Schultz*: col. 6, lines 50-61)—devices well known for their alpha-numeric scanning capabilities.

In short, the combined teachings of *Ballantyne, Evans, Lavin* and *Schultz*, in toto, do indeed teach, suggest, and disclose Applicant's claimed invention, as recited in the claims.

(B) Applicant's remaining arguments in the response filed 10/3/07 rely on or re-hash the issues addressed above and in previous Office Actions and therefore, are moot in view of the responses given previously and incorporated herein.

### ***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mike Tomaszewski whose telephone number is (571)272-8117. The examiner can normally be reached on M-F 7:00 am - 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571)272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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MT



*Robert Morgan*  
**ROBERT W. MORGAN**  
PRIMARY EXAMINER  
TECHNOLOGY CENTER 3600